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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,993	07/13/2001	Patricia Preikschat	31716US1	3817

116 7590 06/04/2003

PEARNE & GORDON LLP
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CLEVELAND, OH 44114-1484

EXAMINER

KOEHLER, ROBERT R

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 06/04/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant N .

09/904,993

Applicant(s)

PREIKSCHAT ET AL.

Examiner

Robert R. Koehler

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2003. (Amendment)
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 and 48-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 and 48-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/171,558.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 to 46 and 48 to 65 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 62 of U.S. Patent No. 6,287,704 (Preikschat, et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to process steps, process conditions, conversion coating solution compositions, a concentrate solution for producing conversion coating solutions, and a conversion coating layer on zinc or a zinc alloy substrate wherein the claimed process, conversion coating solution composition, concentrate solution for producing a conversion coating solution, and the conversion coating layer includes trivalent chromium (chromium (III)) as a passivating component, does not include any hexavalent chromium (chromium (VI)), does not include (or utilize) any fluoride ion or any other fluorine-containing chemical species in order to satisfy the claimed requirement that "the chromium (III) is present in the form of at least one complex having ligand replacement kinetics more rapid than the fluoride replacement kinetics in chromium (III)-fluorocomplexes," and is

Art Unit: 1775

capable of providing corrosion protection of about 100 to 1000 hours in the salt spray test according to DIN 50021 SS or ASTM B 117-73 until first attack according to DIN 50961 Chapter 10. The Examiner believes that applicants' claims and the patent claims contain overlapping process conditions, overlapping conversion coating solution compositions, and overlapping conversion coating compositions.

Response to Arguments

Applicant's arguments filed on March 20, 2003 have been fully considered but they are not persuasive. The Examiner has given very careful consideration to applicants' remarks concerning the rejection of claims under 35 U.S.C. § 103(a). The Examiner withdraws the rejection of all claims under 35 U.S.C. § 103(a) in view of applicants' detailed remarks about the Klos, et al. patent reference and the Bourke, et al. journal article reference. However, the Examiner believes that the issue of obviousness-type double patenting exists between the application claims and the patent claims of U.S. Patent No. 6,287,704.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Robert Koehler whose telephone number is (703) 308-1974. The Examiner can normally be reached on Tuesday to Friday from 8:30 AM to 6:00 PM. The Examiner can also be reached on alternate Mondays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Deborah Jones, can be reached on (703) 308-3822. The fax phone number for this Art Unit is (703) 872-9310. Any inquiry of a general nature or relating to the status of this

Application/Control Number: 09/904,993

Page 4

Art Unit: 1775

application or proceeding should be directed to the Technology Center receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read "Robert R. Koehler". The signature is written in a cursive, flowing style.

ROBERT R. KOEHLER
PRIMARY EXAMINER

Art Unit 1775

June 2, 2003